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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK A. TERRIBILE

Appeal 2008-003097
Application 09/850,301¹
Technology Center 2400

Decided: ² May 27, 2009

Before LEE E. BARRETT, LANCE LEONARD BARRY, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

C. THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed May 7, 2001. The real party in interest is Lucent Technologies Inc.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1-20, 22-31, and 33-42³ mailed March 28, 2006, which are all the claims remaining in the application, as claims 21 and 32 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

A. INVENTION

Appellant invented an apparatus, method, and computer readable medium for building a table to select r most frequently used Internet site names. (Spec. 16, Abstract.)

B. ILLUSTRATIVE CLAIMS

The appeal contains claims 1-20, 22-31, and 33-42. Claims 1, 6, 16, and 27 are independent claims. Claims 1 and 38 are illustrative:

1. A caching method comprising the steps of:
 - (a) receiving an Internet site name;
 - (b) storing the Internet site name in an entry of a table having n entries if the Internet site name is not in the table;
 - (c) counting the number of times the Internet site name has been received, and if the Internet site name is new and the table is

³ The Examiner objects to claims 1-20, 22-31, and 33-36 (Ans. 3) – a petitionable matter that is not before us. *See* MPEP § 706.01 (“[T]he Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board.”); *see also* MPEP § 1201 (“The Board will not ordinarily hear a question that should be decided by the Director on petition . . .”).

full, selecting an entry from a set of replaceable entries in the table, where the table includes both replaceable and irreplaceable entries;

(d) replacing the selected entry with the new entry; and

(e) caching a resource corresponding to at least one of a most frequently used Internet sites r where $r \leq n$.

38. The method of claim 1 wherein the cached resource is an audio file.

C. REFERENCES

The references relied upon by the Examiner in rejecting the claims on appeal are as follows:

Peercy	US 5,960,429	Sep. 28, 1999
Swildens	US 2001/0034792 A1	Oct. 25, 2001 (Filed Feb. 7, 2001)
Doyle	US 2002/0099807 A1	Jul. 25, 2002 (Filed Jan 22, 2001)
Chauvel	US 6,826,652 B1	Nov. 30, 2004 (Filed Jun. 9, 2000)

D. REJECTIONS

The Examiner entered the following rejections which are before us for review:

(1) Claims 1-15 and 37-40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Peercy in view of Doyle. In addition, Chauvel is used to support well-known teachings; and

(2) Claims 16-20, 22-31, 33-36, 41, and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Peercy in view of Doyle and Swildens.

II. PROSECUTION HISTORY

Appellant appealed from the Final Rejection and filed a corrected Appeal Brief (App. Br.) on December 15, 2006. The Examiner mailed a substitute Examiner's Answer (Ans.) on June 4, 2007. Appellant filed a supplemental Reply Brief (Reply Br.) on July 3, 2007.

III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Peercy

1. Peercy discloses that "[a] count of retrievals of a web page is accumulated and the accumulated count and an address for the web page are stored in a record of a history log database at the network server." (Col. 1, ll. 49-52.)

2. In Peercy, "[t]he database may be a table comprised of rows and columns, . . . each row of the table typically includes a name or title for the web page 26, an HTTP URL 28 for the web page, and a counter 30 that is incremented every time the web page is accessed." (Col. 4, ll. 30-37.)

3. Peercy discloses that "[i]f the web page is of some interest to the user, they 'bookmark' the HTTP Uniform Resource Locator (URL) for that page in their browser in order to easily find the web page in the future." (Col. 2, ll. 28-31.)

Doyle

4. Doyle discloses:

As shown in FIG. 4, in Step 400, a determination is made whether the cache of the server is full. . . . [E]ach of the pages stored in the cache is associated with the generation cost information identifying the generation cost of that page. If in Step 400 the determination indicates that the cache is full, the generation cost tag(s) associated with the current page are examined in Step 410. Then in Step 420, the generation cost information associated with each of the pages stored in the cache is examined to search for a cache entry having the page generation cost that is lower than the generation cost of the current page. . . . If, in Step 425, the search indicates that a cache entry with a lower generation cost is found, the lower-cost cached entry is replaced with the current page

(Page 3, ¶ [0026].)

5. Doyle discloses that

other schemes may be utilized to narrow the entries to one. For instance, applying the conventional Least Recently Used (LRU) method or Hit Count method herein, from the multiple cached entries that are found, the entry that was least recently or least frequently accessed by the user may be replaced with the current page and its tags.

(Page 3, ¶ [0026].)

Chauvel

6. Chauvel discloses that “[s]ome cache systems provide mechanisms for locking entries in a cache, so that the cache entries will not be overwritten as other locations are accessed.” (Col. 1, ll. 49-51.)

7. Chauvel discloses that “locking entries of a cache reduces the size and associativity of the cache. . . . greatly reducing the efficiency of the cache.” (Col. 1, ll. 53-56.)

IV. PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants’ Brief to show error in the proffered *prima facie* case. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief has not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

V. ANALYSIS

Grouping of Claims

In the Brief:

Group I: Appellant argues claims 1-15, 37, and 39 as a group (App. Br. 6-7). For claims 2-15, 37, and 39, Appellant repeats the same argument made for claim 1. We will, therefore, treat claims 2-15, 37 and 39 as standing or falling with claim 1.

Group II: Appellant argues claims 16-20, 22-31, 33-36, and 41 as a group (App. Br. 7-8). For claims 17-20, 22-31, 33-36, and 41, Appellant repeats the same argument made for claim 16. We will, therefore, treat claims 17-20, 22-31, 33-36, 41, and 42 as standing or falling with claim 16.

Group III: Appellant argues claims 38, 40, and 42 as a group (App. Br. 8). For claims 40 and 42, Appellant repeats the same argument made for claim 38. We will, therefore, treat claims 40 and 42 as standing or falling with claim 38.

See 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

The Obviousness Rejection

We now consider the Examiner's rejection of the claims under 35 U.S.C. § 103(a).

Group I

Claims 1-15, 37, and 39

Appellant contends that Chauvel “does not disclose or suggest the selection of an entry from a set of replaceable entries in a table, where the

table includes both replaceable and irreplaceable entries as in claims 1-15 and 37-40.” (App. Br. 7; *See* also Reply Br. 2) Appellant further contends that “[w]hile Chauvel appears to disclose some type of irreplaceable entry (e.g., Chauvel’s ‘locked entries’) it does not disclose or suggest replaceable entries.” (App. Br. 7.)

The Examiner used Chauvel to support well-known teachings (Ans. 4) and took Official Notice that a “table including both replaceable and irreplaceable entries is well-known” (Ans. 4-5).

Issue: Has Appellant shown that the Examiner erred in finding that it is well known for a table to include both replaceable and irreplaceable entries?

In essence, the only feature disputed in representative claim 1 by Appellant regards the feature - “the table includes both replaceable and irreplaceable entries.” Peercy discloses keeping a count record in a table of retrieved web pages every time the web page is accessed (FF 1-2). Similarly, Doyle discloses storing web pages whereby a determination is made as to whether a cache is full, and if so, a search is done to find an entry that can be replaced (i.e., replaceable entry) (FF 4). Doyle further discloses that several schemes may be used for replacing entries including the conventional Least Recently Used (LRU) method or the Hit Count method (FF 5). Thus, the combination of Peercy and Doyle discloses counting the number of times the Internet site name has been received, and if the Internet site name is new and the table is full, selecting an entry from a set of replaceable entries in the table. While the Examiner has not shown that

Peercy and Doyle expressly disclose irreplaceable entries in the table, the Examiner took Official Notice that such a feature is well-known and introduced Chauvel to make reference thereto (Ans. 4-5). Specifically, Chauvel discloses that some cache systems provide locked entries in the cache (FF 6).

Because it is undisputed that the combination of Peercy and Doyle teaches every element of the device of claim 1 but for the “irreplaceable entries,” the sole difference between Appellant’s claim 1 and the teachings of Peercy and Doyle is having irreplaceable entries in a table. In that regard, Chauvel shows that it was known in the art at the time of the invention to use locked entries in a cache (FF 6-7). We find, based on our examination of the prior art and the state of the art in cache devices, that the cited art evidences a common usage of replaceable and irreplaceable cache entries.

Since each individual element and its function, as described in claim 1, as shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and that of the prior art rests not on any individual element or function but in the very combination itself.

Appellant further contends that “Chauvel explicitly teaches away from using irreplaceable entries to operate a cache.” (App. Br. 7.)

Specifically, Chauvel discloses that locking entries of a cache reduces the size of the cache and reduces the efficiency of the cache (FF 7). However, we do not find, and Appellant does not establish, that Chauvel criticizes, discredits, or otherwise discourages the use of locked cache entries. “[T]he prior art’s mere disclosure of more than one alternative does

not constitute a teaching away from any of these alternative because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, . . . would be led in a direction divergent from the path that was taken by the applicant.” *In re Haruna*, 249 F.3d 1327, 1335 (Fed. Cir. 2001) (omission in original) (citing *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999)). We do not find this to be the situation before this Board. We find that being less efficient is not a teaching away. “A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

As to the other recited elements of claim 1, Appellant provides no argument to dispute that the Examiner has correctly shown where all these claimed elements appear in the prior art. Thus, we deem those arguments waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Thus, Appellant has not persuaded us of error in the Examiner’s conclusion of obviousness for representative claim 1. Therefore, we affirm the Examiner’s § 103 rejection of independent claim 1 and of claims 2-15, 37, and 39, which fall therewith.

Group II
Claims 16-20, 22-31, 33-36, and 41

Appellant contends that “each of these claims also includes the feature of a table that includes both replaceable and irreplaceable entries and that Swildens does not make up for the deficiencies of Peercy or Doyle set forth above.” (App. Br. 7.)

The Examiner found that the “limitations of claims 16-20, 22-31, 33-36, and 41-42 that are similar to limitations of claims 1-5 and 37-38 are being rejected under the same rationale.” (Ans. 6.)

Issue: Has Appellant shown that the Examiner erred in using the same rationale for rejecting the limitations of claims 16-20, 22-31, 33-36, and 41-42 that are similar to limitations of claims 1-5 and 37-38?

While Appellant’s arguments refer to the “replaceable and irreplaceable entries” feature of the above-noted claims, Appellant fails to recognize that the Examiner is relying on the same reasoning used in rejecting claim 1 to reject this feature in representative claim 16, i.e., well-known as shown in Chauvel (Ans. 6). As noted *supra*, we find that the Examiner has set forth a sufficient initial showing of obviousness regarding this feature. Examiner imports Swildens merely to disclose the hashing feature (Ans. 6), which is undisputed by Appellant.

As to the other recited elements of the above-noted claims, Appellant provides no argument to dispute that the Examiner has correctly shown where all these claimed elements appear in the prior art. Thus, we deem those arguments waived. See 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Thus, Appellant has not persuaded us of error in the Examiner's conclusion of obviousness for representative claim 16. Therefore, we affirm the rejection of independent claim 16, and of claims 17-20, 22-31, 33-36, and 41, which fall therewith.

Group III
Claims 38, 40, and 42

Appellant contends that claims 38, 40, and 42

include[] the feature of an audio file, cached resource. In the Final Office Action the Examiner takes the position that an excerpt from Percy (column 2, lines 19-31) discloses a 'multimedia file' which, in turn, is a disclosure of the claimed audio file. However, this excerpt from Percy is totally silent with respect to either a multimedia or audio file.

(App. Br. 8.) Appellant further contends that "while an HTML-formatted page may include audio information, by no means is the phrase 'HTML' synonymous with such information, nor must an HTML page include such information, as the Examiner appears to suggest." (Reply Br. 3.)

The Examiner found that "Percy teaches server caches HTML file [sic] which inherently includes multimedia file" (Ans. 8).

Issue: Has Appellant shown that the Examiner erred in finding that Percy inherently teaches that the cache resource is an audio file?

Percy discloses book-marking HTTP URL for pages of interest (FF 3). The Examiner found that caching an HTTP URL inherently includes caching an audio file. We disagree.

“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted). When relying upon a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the Examiner’s determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990).

While it seems logical that a web page could include an audio file, our reviewing court has determined that “[i]nherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d at 745. The Examiner has left it up to us to speculate. We decline to engage in speculation in deciding this appeal.

Therefore, we find that the Examiner has *not* set forth a sufficient showing of obviousness, and that the Appellant has shown error in the Examiner’s rejection of claim 38. Therefore, we reverse the rejection of claim 38, and of claims 40 and 42, which stand therewith.

VI. CONCLUSIONS

We conclude:

Appellant has *not* shown that the Examiner erred in rejecting claims 1-20, 22-31, 33-37, 39, and 41.

Appellant has shown that the Examiner erred in rejecting claims 38, 40, and 42.

VII. DECISION

In view of the foregoing discussion:

We affirm the Examiner's rejection of claims 1-20, 22-31, 33-37, 39, and 41.

We reverse the Examiner's rejection of claims 38, 40, and 42.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

msc

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